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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,762	02/15/2005	Werner Bonrath	K21364USWO (C038435/01843)	3414
7590 Stephen M Haracz Bryan Cave 1290 Avenue of the Americas New York, NY 10104			EXAMINER GALE, KELLETTE	
			ART UNIT 1621	PAPER NUMBER
			MAIL DATE 08/06/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,762	<b>Applicant(s)</b> BONRATH ET AL.	
	<b>Examiner</b> KELLETT GALE	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-31 are pending in this application.

Claims 1-31 have been rejected in this application.

### ***Response to Amendment***

The amendment to the application filed, April 28, 2008, has been received and acknowledged by the Examiner.

### ***Response to Arguments***

Applicant's arguments filed April 28, 2008 have been fully considered but they are not persuasive. Applicant has argued that the prior art has used a powdered alkali metal hydroxide instead of the claimed aqueous alkali metal hydroxide and art as a whole teaches away from the aqueous alkali metal hydroxide. Also, applicants have asked the Examiner to review the declaration filed October 9, 2007 for unexpected results.

The Examiner contends that although it is stated that a powdered alkali metal hydroxide is used, it is upon reaction and when the powdered alkali metal hydroxide is in solution that it becomes aqueous. Therefore, it may not be explicitly taught that an aqueous alkali metal hydroxide is used, but it is inherent that the alkali metal hydroxide is aqueous once the reaction has started.

The Examiner contends that the art does not teach away from the use of the alkali metal hydroxide being used in aqueous form since the art, in fact, puts the alkali

Art Unit: 1621

metal hydroxide in solution in order to carry out the reaction. That alone makes the alkali metal hydroxide aqueous.

Also, the Examiner and her supervisor has once again reviewed the Bonrath declaration and found that the deviations that occur in the experimental results shown by Bonrath are simply deviation due to optimization and that it is obvious to expect for the conversion to product to be lower with a lower KOH:SC ratio and vice versa. The byproduct yield is much smaller than the product yield and therefore, any changes in product yield that correlate with the small changes in by product (ex., 1.4% to 3.6% of total conversion) would be difficult to measure accurately for the product, which is at a minimum >90%, In addition, the claim limitations cover any reaction wherein the ratio is 1:200 while the only data provided includes ratios that are much greater than the upper limit of the claims, therefore, even if the results suggested unexpected results, which they do not, those results do not support the full scope of what is claimed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1621

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tedeschi et al (US 3,709,946).

Claims 21-31 are rejected under 35 U.S.C 103(a) as being unpatentable over Tedeschi et al.

Applicant claims a process for the manufacture of an acetylenically unsaturated alcohol comprising reacting a carbonyl compound with acetylene in the presence of ammonia and an alkali metal hydroxide.

#### **Determination of the scope and content of the prior art**

##### **(MPEP §2141.01)**

Tedeschi et al teaches a process for preparing an acetylenic alcohol by reacting a ketone with liquefied acetylene in the presence of a co-catalyst system comprising liquid ammonia and an alkali metal hydroxide.

#### **Ascertainment of the difference between the prior art and the claims**

##### **(MPEP §2141.02)**

Tedeschi et al do not teach the specific ketone. Also, process parameters may not be exactly the same in Tedeschi et al as that which is claimed.

#### **Finding of prima facie obviousness**

##### **Rational and Motivation (MPEP §2142-2143)**

Since Tedeschi et al teaches that any ketone can be used in his process of preparing an acetylenic alcohol; it would be obvious for one having ordinary skill in the

Art Unit: 1621

art at the time of the instant invention to prepare such an alcohol using any ketone and expect to arrive at the desired acetylenic alcohol. One having ordinary skill in the art at the time of the instant invention would be motivated to do so as Tedeschi et al has recited successful results in his examples.

Also, merely modifying the process conditions such as temperature and concentration is not a patentable modification absent a showing of criticality. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLETTE GALE whose telephone number is (571)272-8038. The examiner can normally be reached on M-F (6:30am-3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, YVONNE EYLER can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Kellette Gale  
Patent Examiner  
Technology Center 1600

**July 30, 2008**

/Daniel M Sullivan/  
Supervisory Patent Examiner, Art Unit 1636